

## **REMARKS**

### **Status of the Claims**

Claims 1-73 are in the application, of which claims 1, 69, and 70 are in independent form. Claims 64-69 are withdrawn.

### **Amendments**

The Abstract is amended in accordance with the examiner's suggestion.

### **Rejection Under 35 U.S.C. § 103**

Claims 1-63 and 70-73 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,482,262 of Elers et al. Applicant respectfully traverses. The Office action acknowledges that Elers et al. "does not specifically teach that the chemical must be an organometallic chemical." The Office action then states that Elers et al. "fairly teaches the use of organometallic materials as an appropriate source compound (col. 5 line 7 – col. 6 line 67)."

### ***Independent Claims 1 and 70***

With respect to independent claims 1 and 70, applicant asserts that the Office action fails to make out a *prima facie* case of obviousness because it does not provide how one of ordinary skill in the art would have been motivated to modify the teachings of Elers et al. from the boron-, phosphorous-, and silicon-containing carbon source materials described therein, to reach the claimed organometallic chemical. Furthermore, by identifying nearly two full columns of text of Elers et al. without any discussion thereof, the Office action fails to identify with any particularity the portions of Elers et al. that are asserted to "fairly" teach the use of organometallic chemicals. Thus, applicant has not been afforded a fair opportunity for reply. 37 CFR 1.104(c)(2); MPEP § 706.02(j) ("It is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.").

### ***Dependent claims 2-63 and 71-73***

The Office action also fails to identify where the cited patent teaches or suggests any of the limitations of the dependent claims 2-63 and 71-73. Applicant is unable to find any teaching or suggestion in Elers et al. of the elements of the dependent claims and, therefore, respectfully traverses. For example, the Office action does not point out where in Elers et al. it is taught or suggested to use organometallic chemicals such as trimethylaluminum, as claimed in claim 19, or dimethylaluminum chloride, as claimed in claim 21; and, furthermore, the Office action fails to identify

where Elers et al. teaches or suggests the use of any metal at all in the carbon source compound (e.g., claims 15, 16, 22, 28, 48, and 49). Since the Office action does not identify all of the elements of claims 15, 16, 19, 22, 22, 28, 48, and 49 (and others), and indeed claims 15, 16, 19, 22, 22, 28, 48, and 49 (and others) are not even specifically identified in the Office action, the rejection is incomplete and should be withdrawn.

***Reasonable expectation of success***

The Office action states that "one skilled in the art would reasonably expect that the deposition would be fully successful with the use of any of the materials listed" in the dependent claims. However, the Office action does not identify any basis for such a reasonable expectation of success. Moreover, some dependent claims include additional limitations that do not relate to the materials used in the process and which are not otherwise discussed in the Office action. The examiner has clearly failed to make out a *prima facie* case of obviousness with respect to dependent claims 2-63 and 71-73.

***No Prima Facie Case***

Applicant believes the examiner has failed to make out a *prima facie* case of obviousness with respect to any of the claims. As set forth in the Manual of Patent Examination Procedure:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

MPEP § 706.02(j).

As set forth above, the Office action fails to make out a *prima facie* case because it fails to identify where all of the claim limitations appear in the cited patent. Thus, it is requested that a reference be cited disclosing the limitations or the rejection be removed. MPEP § 2144.03.

The Office Action also fails to set forth a *prima facie* case of obviousness because there is no discussion in the Office Action as to a suggestion or motivation to modify the reference, nor would there be a reasonable expectation of success for such a

modification. Moreover, the Office action fails to identify any instance in the cited patent wherein the required teaching or suggestion to modify the reference is found. Accordingly, applicant respectfully asserts that the examiner has failed to make out a *prima facie* case of obviousness and requests withdrawal of the rejection.

**Further Action**

In the event that the examiner continues to apply Elers et al. as a basis for rejection, applicant respectfully requests that the examiner point out with particularity the places in the reference that are asserted as corresponding to the various elements of the claims, and, further, clearly identify the particular modification(s) of the teachings of Elers et al. and any other references the examiner may decide to cite in combination, and the motivation or suggestion therefor. Applicant respectfully requests that any subsequent action be made non-final so that applicant may have a fair opportunity for reply. 37 CFR 1.104(c)(2).

**Conclusion**

Applicant respectfully traverses and requests reconsideration. Applicant invites the examiner to contact the undersigned by telephone, in the event that the examiner believes there are any outstanding issues that can be easily resolved by telephone.

Respectfully submitted,

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